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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,992	03/28/2001	Bradford H. Needham	P 0275014 P10427	9762
27496	7590	03/11/2004	EXAMINER	
PILLSBURY WINTHROP LLP			KIM, AHSHIK	
725 S. FIGUEROA STREET			ART UNIT	
SUITE 2800			PAPER NUMBER	
LOS ANGELES, CA 90017			2876	

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/818,992	<b>Applicant(s)</b> <input checked="" type="checkbox"/> NEEDHAM ET AL.	
	<b>Examiner</b> Ahshik Kim	<b>Art Unit</b> 2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/25/03 (RCE).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in  
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is  
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)  
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to  
37 CFR 1.114. Applicant's submission filed on November 25, 2003 has been entered.

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### ***Preliminary Amendment***

2. Receipt is acknowledged of the preliminary amendment filed on November 25, 2003. In  
the amendment claims 1, 7, 19, 21, and 24 were amended, and claims 28-35 were newly added.  
Currently, claims 1-35 remain for examination.

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### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on  
sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 5-8, 10-13, 17, 19-27, and 28-35 are rejected under 35 U.S.C. 102(b) as  
being anticipated by Tracy et al. (US 5,979,757).

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Re claims 1-2, 5-8, 10-13, 17, 19-27, and 28-35, Tracy et al. discloses a system/method a handheld recommendation assistant 70 comprising reading, by a barcode scanner 75 or a RFID tag reader (col. 3, lines 3-1-38), the product information of a product from a product tag (i.e., a UPC code/barcode tag or a RFID tag); retrieving consumer information through a connection  
5 (i.e., a connection network/LAN) (col. 9, lines 6-55) to a consumer information storage device (i.e., a database of a remote server or a local database stored on customer's identification card, which can be a smart card (or a floppy disk (col. 13, lines 34+)); acquiring personal information of a user relevant to at least one aspect of the product through an interface on the handheld device (i.e., a touch sensitive display, which serves as an interface for inputting personal  
10 information (e.g., password, etc.)), generating a product recommendation related to the product based on at least in part on the personal information and the consumer information (col. 9, lines 55+ and 60+), wherein generating a product recommendation comprising comparing the personal information and the consumer information to produce a comparison result, identifying at least one recommended product whose consumer information is consistent with the personal  
15 information, and recommending the at least one recommended product via the display 72 (i.e., price, product name, quantity, recipes, nutritional information and promotion, etc.), wherein the product recommendation is determined by a remote server, which is a central host (col. 14, lines 15+ and lines 60+ and col. 15, lines 34+). See figs. 1-4 and 7A-E; col. 3, lines 30+; col. 4, lines 1-42; col. 5, lines 36+; col. 6, lines 39+ and lines 57+; col. 7, line 34 through col. 11, line 28; and  
20 col. 13, lines 34+.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the  
10 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)  
15 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3-4, 9, and, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. in view of Suzuki (US 6,129,274). The teachings of Tracy et al. have been discussed above.

Re claims 3-4, 9, and 13-16: Tracy et al. has been discussed above but fails to teach or  
20 fairly suggest that the personal information including tailoring measurements, a color preference. Suzuki teaches the above limitation with the personal information including tailoring measurements, a color preference (col. 4, lines 20+ and col. 10, lines 55+).

In view of Suzuki's disclosure, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of into Suzuki the  
25 teachings of Tracy et al. in order to provide the user/customer is provided with a complete recommendation of products that is fit to his/her needs (i.e., his/her desired size and color), and

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thus providing a more user friendly system. Furthermore, such modification would have been an obvious extension as taught by Tracy et al., and therefore an obvious expedient.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. The teachings of Tracy et al. have been discussed above.

5 Re claim 18, Tracy et al. has been discussed above but fails to teach or fairly suggest the step of storing the product information in a machine readable form in the product tag; and attaching the product tag containing the machine readable product information to the product.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the step of storing the product information in a machine  
10 readable form in the product tag and attached the product tag to the product in order to provide Tracy et al. with a faster system wherein the product information can be retrieved readily one the product tag is read by the handheld device, and thus providing a time consuming system. Furthermore, such modification would have been an obvious extension as taught by Tracy et al., and therefore an obvious expedient.

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***Response to Remarks***

9. Applicant's remarks filed on November 25, 2003 have been carefully considered, but they are not persuasive.

Examiner notes that Applicant further limited the claims to overcome the Tracy patent.  
20 However, it is Examiner's opinion that the portable terminal disclosed in Tracy still read on the subject matter presented in the amended claims.

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As shown in figure 3, the scanner 70 includes a processor (CPU) 701, radio 702, scanning subsystem 704, the vide subsystem 705, etc. (col. 5, lines 25+). Therefore, the hand-held device has a processor housed within the device.

Applicant, however, argues that the terminal of the Tracy is “merely a “dumb” device”.

5 Applicant also states on page 14 of the remarks, “Moreover, Tracy teaches away from the portable terminal 100 performing such recommendations. Specifically, Tracy teaches the following (with emphasis added) at col. 3, line 49-54:

10 “Data collected with the portable terminal is communicated to a central host. In a preferred embodiment, the central host performs most of the computing function, thereby reducing the computational memory and power requirements of the portable terminals communicating with the system.”

In responding to Applicant’s argument, Tracy’s terminal should not be a repository of all customer profile data, or prior purchase data, which requires large storage area. The central host  
15 should have a capacity to keep all the records for the system (col. 6, lines 27+). The portable terminal, however, contains enough memory for keeping track of scanned items (col. 1, lines 37-55) and to receive data downloaded to the terminal from the host (col. 2, lines 30-40).

Downloaded information often includes a picture, audio or video data which can be large files compared to text. As already shown in figure 3, there should be enough memory space to enable  
20 various subsystems – scanning, telephone, video subsystem, etc. and the software to enable the subsystem and the actual application for the users. When a customer starts shopping his/her preferences is downloaded to the terminal (col. 9, lines 6+). Accordingly, user-friendly features or recommendation (col. 10, lines 10+) such as displaying friendly message and a happy face (col. 11, lines 29+) would occur within the terminal.

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Applicant's amended claims and newly added claims are carefully considered, but the cited references, taken alone or in combination teach the claimed subject matter.

Upon further search, however, the Examiner found several references, which are cited in this Office Action. Applicant is respectfully suggested to carefully review these prior arts.

5

### Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Sloane et al. (US 6,434,530); Treyz et al. (US 6,587,835); Ogasawara (US 6,386,450); Suzuki (US 6,129,274) disclose various shopping assistant apparatus. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim  
Patent Examiner  
Art Unit 2876  
March 4, 2004

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